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PATENT
APPLICATION 10/563,187
ATTORNEY DOCKET 1043-005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) **de Janasz, Christopher G.**
Application **10/563,187**
Confirmation **5857**
Filed **30 December 2005**
Application Title **Vehicle-Based Wireless Identification System**
Art Unit **3621**
Latest Examiner **Le, Nancy Loan T.**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW OFFICE ACTION FINALITY

Applicant respectfully petitions the Commissioner to withdraw the finality of the Office Action dated 9 October 2007 due to that Office Action's failure to address the substance of Applicant's arguments traversing rejections of at least each of claims 1-33.

Under MPEP 706.07(a) (emphasis added):

[u]nder present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).**

The present Office Action admits that a new ground of rejection is presented regarding each of independent claims 1, 14, and 15. See Pages 1, 2, 5, 6, 7, and 8. For example, regarding claim 1, the present Office Action states, at Page 2:

the USPTO interprets claim limitations that contain 'if, may, might, can, when and could' statement(s), as optional language. As matter of

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linguistic precision, optional claim elements *do not narrow claim limitations*, since *they can always be omitted* (In re Johnston, 77 USPQ2d 1788 (CA FC 2006)). Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does *not* limit the scope of a claim or claim limitation.

This new ground of rejection was neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Thus, the present Office Action should not have been made final.

Moreover, MPEP 707.07 requires that an Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and must answer in detail the substance of each of the submitted arguments.

In response to an Office Action dated 29 June 2006, Applicant filed a proper Reply on 5 June 2007, which is incorporated herein by reference. In traversing a rejection of each of claims 1-33, Applicant presented numerous arguments that stand unopposed in the present Office Action. For example, regarding claim 1, Applicant argued:

Marshall allegedly asserts, at the Abstract:

[a]n illumination tool for projecting a light beam through a transparent structure that has a portion of the tool detachably securable via a vacuum seal mechanism that engages the transparent structure. A lighting mechanism is electrically attached to the illumination tool and is positioned in contact with the transparent structure via a soft seal positioned about the lighting mechanism. The lighting mechanism may, if desired, be manually activated and deactivated i.e., the illumination tool turned on or off. If desired, the illumination tool may be remotely operated by a user depressing a remote operating switch and a radio signal is communicated to the illumination tool. The remote actuator may also be hardwire connected to the illumination tool.

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Further, if desired the lighting mechanism may be illuminated via strobe light, a continuous or flashing beam of light.

Thus, Marshall relates to an "illumination tool".

By contrast, claim 1 recites "receiving an approval from the central processor to complete the proposed transaction, the proposed transaction involving the valid financial account associated with the unique identifier."

One skilled in the art at the time of the invention would not have found an "illumination tool" to be in the same field of endeavor as "receiving an approval from the central processor to complete the proposed transaction, the proposed transaction involving the valid financial account associated with the unique identifier."

Likewise, one skilled would not find "illumination tool" to be "reasonably pertinent to the particular problem with which the inventor was involved" in "receiving an approval from the central processor to complete the proposed transaction, the proposed transaction involving the valid financial account associated with the unique identifier."

Further, because they are directed at vastly different problems, one of skill in the art would not consider Marshall to be pertinent art to that of Slavin, Kolls, and/or Valdes-Rodriguez.

Thus, Marshall is not pertinent to the present Application and is therefore not available as a reference for combination with Slavin, Kolls, and/or Valdes-Rodriguez.

The present Office Action fails to respond whatsoever to this previously presented and persuasive argument or any of many other arguments traversing the rejections of each of claims 1-33. Instead, the present Office Action merely asserts, at Page 1, "Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection as follows." Applicant respectfully submits that the "arguments" that were presented are not, and were not, "moot". The substance of those arguments is indeed repeated herein. With the exception of an application of an impermissible and legally erroneous *per se* rule used

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as a part of the rejection of each of independent claims 1, 14, and 15, the present Office Action is a verbatim copy of the Office Action dated 29 June 2006.

For at least these reasons, Applicant respectfully submits that the finality of the 9 October 2007 Office Action is premature and respectfully requests a withdrawal of the finality thereof.

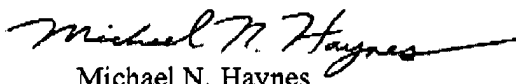
Submitted herewith please find the Petition fee under 37 C.F.R. 1.17 (h), which Applicant respectfully requests be refunded.

CONCLUSION

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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Date: 08 January 2008

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